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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,387	02/21/2001	Makoto Suzuki	1046.1243 (JDH)	5408
21171 7590 10/24/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER VILLECCO, JOHN M	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 10/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/788,387

Applicant(s)

SUZUKI ET AL.

Examiner

John M. Villecco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-14,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-9,12-14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments filed August 29, 2007 have been fully considered but they are not persuasive. Applicant has amended each of the independent claims (claims 1, 7, 12, and 16) to include the limitation of "said sequence of images is adjusted responsive to a display order indicated by a user". This newly amended claim language does not appear to overcome the prior art of record. Please see the grounds of rejection for the previously pending claims on the following pages.
2. Also, applicant has added new claim 17. Please see the new grounds of rejection for claim 17 on the following pages. Furthermore, claim 17 introduces new matter. See the 112, 1<sup>st</sup> paragraph rejection on the following pages.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, claim 17 includes the limitation of "sorting said images according to an order

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identified by a user prior to said displaying and providing the images in accordance with said sorting, *where said order is based on an attribute of an image among said images photographed*' (emphasis added). After a thorough review of the specification, the only mentioning of the attributes of an image occurs on page 14, lines 14-18, page 15, lines 5-9, page 22, lines 14-17, and page 33, lines 1-4. None of these passages describe a situation in which the order identified by a user is based on an attribute of an image. Thus, this newly added claim constitutes new matter.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 7, 12, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Sato (U.S. Patent No. 6,515,704).**

7. Regarding *claim 1*, Sato discloses a method for sensing and displaying captured images. More specifically, Sato discloses a camera which includes a control section (7), an image sensor (1), a memory (5), and a display (9). The camera operates such that upon determination of whether a photographing operation is performed, a preview image, which was previously displayed in section (101) of the display, is sent to the memory (5), processed and then displayed in the periphery section of the display. See column 4, line 59 to column 5, line 8. Inherently, the

control section (7) would be used to detect the photographing instruction from the operating section (12). The display area (101) is interpreted to be the first display area and the display areas (102-113) are interpreted to be the second display area. Sato discloses a method in column 6, line 55 to column 7, line 13 and Figure 9, in which a newly captured image is inserted at a position between images of the sequence of images. More specifically, when a new image is captured, this image is displayed in the oldest image captured in the second display area.

Furthermore, Sato discloses that during the process of inserting image data in a position among a sequence of image data, the sequence of image data is adjusted responsive to a display order indicated by a user. More specifically, the position of insertion of the newly captured image data results in the camera adjusting the sequence of image data. This is done responsive to a display order indicated by a user, since the user is able to select the position of insertion.

8. **Claim 7** is considered substantively equivalent to claim 1 with the added limitations of the method steps being stored in a storage medium readable by a machine. It is inherent that the control section (7) of Sato includes a storage medium for storing instructions for carrying out the display process. Also, Sato discloses that the functions of the disclosed camera are implemented using readout program codes (col. 8, lines 41-43). Please see the discussion of claim 1 on the previous pages.

9. **Claim 12** is considered substantively equivalent to claim 1. Please see the discussion of claim 1 above.

10. **Claim 16** is considered substantively equivalent to claim 1 with the added limitations of the operations being stored in a computer readable storage medium. It is inherent that the control section (7) of Sato includes a storage medium for storing instructions for carrying out the display

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process. Also, Sato discloses that the functions of the disclosed camera are implemented using readout program codes (col. 8, lines 41-43). Please see the discussion of claim 1 on the previous pages.

11. **Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Anderson (U.S. Patent No. 6,538,698).**

12. Regarding *claim 17*, Anderson discloses a method of displaying sorted images to a user. More specifically Anderson discloses the ability to generate image data corresponding to images photographed using the imaging device (114) and displaying the captured images using the LCD screen (402). Additionally, Anderson discloses the ability to sort images according to an order specified by the user prior to displaying and providing the images in accordance with the sorting. As discussed in column 6, lines 15-35, the camera of Anderson has the capability of sorting image according to categories specified by the user, such as dates, animal shots, vacation, etc. Furthermore, the category tags are considered attribute data of the image.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 4, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (U.S. Patent No. 6,515,704).**

15. Regarding **claim 4**, as mentioned above in the discussion of claim 1, Sato discloses all of the limitations of the parent claim. However, Sato fails to explicitly disclose that when inserting the image data in a desirable position between the images of the sequence of images, the image data already displayed are shifted frame by frame in a predetermined direction and thus displayed. As described above in the discussion of claim 1, Sato discloses an embodiment in which newly captured images are displayed in the position of the oldest captured image. Thus, the newly captured image is always displayed in a different position and a mark is used to identify the newest image (col. 7, lines 12-14). Additionally, the system inherently moves the oldest captured image to the next index page. Sato also discloses another embodiment in which the display position is always kept the same. The method of always displaying a newly captured image at a predetermined window is desirable because the user can always recognize the last image captured at a glance (col. 6, lines 51-53). One of ordinary skill in the art would easily have been motivated to merge the two embodiments disclosed by Sato so that the position of the newly captured image is maintained, while also maintaining the newest images on the second display screen. This allows for a display arrangement in which the display of the newest captured images are always displayed on the display, while always displaying the newest position at a predetermined position. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to merge the two embodiments of Sato so that the newest group of images are always displayed on the second display, while maintaining the position of the newest captured image so that a user can quickly recognize the last image captured at a glance (col. 6, lines 51-53).

16. **Claim 8** is considered substantively equivalent to claim 5. Please see the discussion of claim 5 on the previous page.

17. **Claim 13** is considered substantively equivalent to claim 5. Please see the discussion of claim 5 on the previous page.

18. **Claims 5, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (U.S. Patent No. 6,515,704) in view of Bullock et al. (U.S. Patent No. 5,943,050).**

19. Regarding **claim 5**, as mentioned above in the discussion of claim 1, Sato discloses all of the limitations of the parent claim. However, Sato fails to specifically disclose that the images are input from an outside device to the display. Bullock, on the other hand, discloses that it is well known in the art to transmit images from a camera directly to computer monitor for display. More specifically, Bullock discloses a camera (118) connected to computer (100) via cable (117). One of ordinary skill in the art would recognize that outputting images to a computer for display offers a myriad of advantages. Computers generally offer bigger displays and increased image processing capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to download the image from the camera of Sato to a computer with a display so that the images can be viewed on a larger monitor and with increased image processing capabilities.

20. **Claim 9** is considered substantively equivalent to claim 5. Please see the discussion of claim 5 on the previous page.

21. **Claim 14** is considered substantively equivalent to claim 5. Please see the discussion of claim 5 on the previous page.



22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

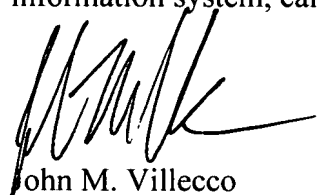
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'John M. Villecco', is written over the printed name.

John M. Villecco  
Primary Examiner, Art Unit 2622  
October 18, 2007